

REMARKS

This Amendment is in response to a March 28, 2005 Office action (Paper No. 3).
Claims 16-27 will be pending. Applicant has amended claim 16 by this amendment.

Claim Objections

In the present Office action, the Examiner objected to claims 20 and 21 because of the phrase “additional circuitry” in describing the transmission of a call origination message from the public/private communication resource to a public mobile BSC. Applicant submits that FIG. 1 clearly shows a line between public/private communication service unit 12 to a public BSC without any additional circuitry in between. This again is also illustrated by Applicant’s FIG. 2. Also paragraph 0029, for example explains this transparent connection between public/private communication service unit 12 and a public BSC, Additional circuitry means no other resources between public/private communication service unit 12 and the public BSC 4_m. The additional circuitry can include landline telephone networks, private mobile resources such as private MSCs, private BSCs etc. Although all these other resources are shown in Applicant’s figures, they are not located between the public/private communication service unit 12 and the public BSC 4_m.

In the Office action, the Examiner objected to claims 25-27 because the Examiner wants each occurrence of “an MS” to be replaced with --a MS--. Applicant disagrees.

Applicant has consulted with numerous dictionaries regarding the definition of “an” and each dictionary states that “an” is used when what follows begins with a vowel *sound*. In claims 25-27, Applicant submits that the letter “M” is pronounced as (em) as is also indicated in the dictionaries. Because “em” begins with a vowel sound, Applicant submits that the “an” before the “MS” is correct and appropriate and thus Applicant traverses the claim objection.

Present Office action is incomplete

On page 19 of the present March 28, 2005 Office action, the Examiner states, “Applicant’s arguments with respect to claims 16-27 have been considered but are moot in view of the new ground(s) of rejection”. However, with reference to the rejection of claims 16 through 19, Applicant has reviewed the rejection of claims 16-19 of the present Office action in view of the previous Office action, the Final Office action mailed August 9, 2004 and cannot find any difference in the rejection of claims 16-19 in the present Office action compared with the rejection of claims 16-19 in the August 9, 2004 Final Office action. Applicant submits that this is in violation of 37 C.F.R. 1.104 (b) and MPEP 707.07 (f) for being incomplete and for failing to address Applicant’s traversals in the Remarks section of the amendment filed on January 3, 2005 as well as failing to comply with the concept of compact prosecution. Applicant therefore requests a new, non-final Office action to remedy the above deficiency.

In addition, Applicant will now repeat Applicant's traversal of claims 16-19 as stated in the Remarks section of the January 3, 2005 RCE amendment for the sake of completeness:

I. Claim 19

In Paper No. 7, the Examiner has finally rejected claim 19 under 35 U.S.C. 102 as being anticipated by USP 5,890,064 to Widergen. Applicant has the following comments.

Regarding Applicant's claim 19, Applicant claims "a public/private **common** cell area". In Paper No. 7, the Examiner states that reference numeral 142 of Widergen '064 is a public/private common cell area. Applicant disagrees. Applicant submits that reference numeral 142 of Widergen '064 is only a private cell area, not a public/private common cell area. Applicant submits that reference numeral 140 of Widergen '064 is a public cell area and not a public / private common cell area. FIG. 1 illustrates the public cell area 140 as being spatially separate from and not overlapping and not in common with private cell area 142. Furthermore, Applicant has reviewed the entire reference to Widergen '064 including the cited sections of col 3, line 61 through col 4, line 19 and col 4, line 27 through col 4, line 33 and cannot find any evidence of a teaching that the public and the private areas are in common with each other. Widergen '064 requires roaming to go from one to the other, while Applicant's claimed invention does not require roaming.

Because Widergen '064 does not teach a common cell area that is common to both public and private cells, the rejection to Applicant's claim 19 must be withdrawn.

II. Claims 16, 17 and 18

In Paper No. 7, the Examiner also rejected claims 16 through 18 under 35 U.S.C. 103 (a) as being unpatentable over Widergen '064 in view of USP 5,537,610 to Mauger. Applicant traverses these rejections for the following reasons:

A. No common cell area

As with claim 19, Applicant claims a public / private common cell area. Applicant submits that neither Widergen '064 nor Mauger '610 teaches such a common cell area.

B. No transparent transmission of a call from a mobile station to a public network

In each of claims 16 through 18, Applicant claims that calls from a mobile station in the common cell area can be transmitted to a public mobile network **transparently**. In Paper No. 7, the Examiner relies on Widergen '064 for a teaching of this transparent transmission feature. Applicant disagrees. Applicant submits that neither Widergen '064 nor Mauger '610 teaches such transparent handling of the calls. In the Widergen '064, calls from CMTs in private cell 142 to a PMT in PLMN 102 (see case 5 for example) are routed through each of a WO Gateway, a PTN, a PSTN a GMSC and a MSC (col. 9, line 39 through col. 10, line 1). Essentially every call from a mobile station in Widergen '064

must go through each of 1) a WO Gateway, 2) a PTN, 3) a PSTN, 4) a GMSC and 5) a MSC. Because all calls from a mobile stations, including calls from private to public mobile network must go through the WO Gateway, PTN, PSTN, GMSC and MSC, Applicant submits that the call handling in Widergen '064 is not transparent.

It is to be appreciate that Applicant's invention is advantageous over the applied prior art by providing a direct connection and interworking between a private mobile and a public mobile network. Applicant submits that this direct connection or interworking is lacking in the applied prior art as such calls from private cell to public cell must go through many networks before being connected.

Prior art rejections of present Office action (Claims 20-27)

Regarding the rejection of newly added claims 22 through 24, in the present Office action, the Examiner has rejected claims 22 and 24 under 35 U.S.C. 103 (a) using Widergen '064 in view of Mauger '610 and further in view of Lu '813. The Examiner has also rejected claim 23 under 35 U.S.C. 103 (a) using Widergen '064 in view of Lu '813. Each of claims 22, 23 and 24 claim that a call from an MS in the common cell to the private mobile service does not go through a public mobile network or a landline network. In the present Office action, the Examiner relies on FIGS, 6A, 7 and 12 of Lu '813 as well as column 15, lines 41-63 and column 6, lines 64-67 of Lu '813 for a teaching of this limitation. Applicant disagrees.

In addition to claiming that a private mobile to private mobile call does not go through public resources and does not go through landline resources, each of claims 22, 23 and 24 also claims that the call origination message is transmitted transparently to a public mobile BSC when the identification information is not included in the call origination message (i.e. , when the call is to a public mobile facility). This can visually be seen by the line in FIG. 1 of Applicant's specification that goes from public/private communications unit 12 to BSC_m 4_m. In Lu '813, if a call is made from an MS unit located within the hybrid or private cell to a public handset 470 as in FIG. 7, the call is handled by cPBX 452, which is analogous to Applicant's public/private communications service unit 12. However, in cPBX 452 of Lu '813, the call is handled by public BSC 476 within the cPBX 452 and the cPBX 452 thus sends the call to public MSC 462. In Applicant's invention, Applicant's public/private communications service unit 12 forwards the call to the public BSC, not the public MSC. Because of this, if Widergen '064 or Widergen '064 in combination with Mauger '610 were to be modified according to Lu '813, Applicant's claimed invention would not result. This is because, if Widergen '064 and/or Mauger '610 were to be modified according to Lu '813, calls from a private cell to a public cell would not ever be transmitted to a public BSC because the public BSC 476 is within the cPBX 452. Instead, the call would be transmitted to the public MSC 462 which is not what Applicant is claiming.

In the rejecting claims 22, 23 and 24, the Examiner is merely picking and choosing

different features from Widergen '064 and Lu '813 and Mauger '610 to reject Applicant's claims. This is not proper. Instead, what should be done is assess what Widergen '064, Lu '813 and Mauger '610 combined as a whole would teach, including conflicting teachings as is required in MPEP 2143.01. In the present case, if Widergen '064 were to be modified according to Lu '813, the cPBX 452 would transmit a private cell to public cell call to public MSC 462, not to a public BSC as claimed by Applicant. Therefore, Applicant submits that one cannot properly infer that Widergen '064 and Mauger '610 modified according to Lu '813 would teach Applicant's claimed invention.

Regarding the rejection of newly added claims 20 and 21, the Examiner rejected these claims under 35 U.S.C. 103 (a) as being unpatentable over Widergen '064 in view of Mauger '610 and further in view of Fujii '918. In claims 20 and 21, Applicant claims that calls from an MS in the common cell area to a public mobile network are directly connected with a public mobile network without having to go through additional circuitry. In the present Office action, the Examiner turns to FIG. 1 and column 2, lines 25-45 of newly cited Fujii '918 for a teaching of this feature. Applicant disagrees.

Applicant submits that if Widergen '064 and Mauger '610 were to be modified according to Fujii '918, Applicant's claimed invention would not result. This is because Fujii '918, unlike Widergen '064, Mauger '610 and Applicant's invention, pertains to a Personal Handyphone System (PHS). Applicant submits that a PHS is very dissimilar to

Applicant's combined public mobile and private mobile communication service and is also dissimilar to the services in Widergen '064 and Mauger '610. A PHS system is a combination of a public cellular system and a cordless telephone receiver. The cordless telephone in a PHS as in Fujii '918 is entirely unrelated to a private cellular system. A cordless telephone essentially uses wired public network resources. In contrast, a private mobile or private cellular system has BTSs, BSCs, MSCs, VLR/HLRs and MSs.

Because a combined public mobile telephone system a private mobile telephone system are so dissimilar to a PHS, Applicant submits that one having ordinary skill in the art would not be inclined to turn to Fujii '918 to fill in for the deficiencies of Widergen '064 and Mauger '610.

Further, Applicant submits that if Widergen '064 and Mauger '610 were to be modified according to Fujii '918, Applicant's claimed invention would not result. Applicant submits that if Widergen '064 were to be modified according to Mauger '610, the resultant would be a PHS system with a public mobile system and a cordless phone that uses public wired resources, not a public mobile system combined with a private mobile system as in Applicant's claimed invention. For these reasons, the rejection of claims 20 and 21 must be withdrawn.

Applicant further submits that in the rejection of claims 20 and 21, the Examiner is

attempting to merely pick and choose different features from different references to arrive at Applicant's invention. Applicant submits that this is improper. MPEP 2143.01 states that the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art, and all teachings in the prior art must be considered. Where the teachings of two or more prior art references conflict, the examiner must weigh the power of each reference to suggest solutions to one of ordinary skill in the art. In the present Office action, the Examiner did not do this. Instead, the Examiner merely used the different references to check off each limitation in Applicant's claim, without any thought or consideration regarding conflicting teachings, and teachings that teach away from Applicant's invention. Therefore, Applicant submits that a prima facie obviousness rejection to claims 20 and 21 have not been properly demonstrated in the present Office action.

Regarding the rejection of claims 25 through 27, Applicant claims a common area that provides both public and private mobile services to mobile phones within the cell. In the present Office action, the Examiner states that reference numeral 142 in FIG. 1 of Widergen '064 reads on this common cell area. Applicant disagrees. Applicant submits that reference numeral 142 is a private cell or wireless office cell that is outside the reach of base station 114 in public cell 140. Applicant submits that public cell 140 and private cell 142 in FIG. 1 of Widergen '064 are clearly shown as not being coextensive in space but instead being side by side. Further, the reference to Widergen

'064 clearly teaches that a mobile station must roam from private cell 142 to public cell 140 to access the base station 114. Applicant therefore submits that Widergen '064 not only does not show a common or overlapping public/private mobile cell area, Widergen '064 teaches away from such a common area. Because Widergen '064 does not teach the common cell area as claimed and defined in claims 25 through 27, the rejection must be withdrawn.

Amendment to claim 16

Applicant has amended claim 16 by this amendment to correct for an error.

No fees are incurred by the filing of this amendment.

In view of the above, it is submitted that the claims of this application are in condition for allowance, and early issuance thereof is solicited. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "R. E. Bushnell", written over a horizontal line.

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